

REMARKS

In response to the final Office Action mailed December 11, 2008, and having a period for response set to expire on March 11, 2009, Applicant respectfully requests that the Examiner exercise her discretion to amend the present application in the manner set forth in the above Amendment.

By the above Amendment, the Applicant requests that claims 1-13 and 19-28 be cancelled, without prejudice, and kindly requests the Examiner to enter new claims 29-46.

Support for new claim 29 may be found in Table III, paragraphs [0038], [0017].
Support for new claims 30-31 may be found in paragraph [0019].
Support for new claims 32-41 may be found in originally filed claims 4-13.
Support for new claim 42 may be found in line of paragraph [0010].
Support for new claim 43 may be found in lines 8-10 of paragraph [0014].
Claims 44-46 include the claim features of cancelled claims 3 and 14-18.

Claims 14-18 were previously withdrawn. Upon entry of these amendments, Claims 29-46 will now be pending in this application.

Applicant submits that the Amendment after Final Rejection places this application in condition for allowance by amending the claims in manners that are believed to render all pending claims allowable over the cited art and/or at least place this application in better form for appeal. This Amendment was not earlier presented because Applicant believed that the prior response placed this application in condition for allowance, for at least the reasons discussed in the prior response. Accordingly, entry of the present Amendment, as an earnest attempt to advance prosecution and/or reduce the number of issues, is requested under 37 C.F.R. §1.116.

In view of the above requested amendments to the claims, Applicant respectfully submits that the Office Action's rejections of Claims 1-13 and 19-28 under 35 U.S.C. §103 and §112, second paragraph, are moot. However, in the event the Examiner refuses to enter the present Amendment, Applicant respectfully traverses the rejections as set forth below.

I. Response to Obviousness Rejection Based upon Roberts and Scari

The Office Action rejects claims 1-5, 7-13, and 19-28 pursuant to 35 U.S.C. §103(a) as obvious in view of the combined teachings of U.S. Patent 4,704,322 of Roberts [herein “Roberts”] and U.S. Patent 5,792,713 of Scari, et al. [herein “Scari”]. The Applicant respectfully submits that these rejections are inappropriate and requests that the following comments and observations be considered.

In regards to Claim 1, in determining obviousness under 35 U.S.C. §103, the Supreme Court recently emphasized that the proposed combination of cited art must “yield predictable results to one of ordinary skill in the art.” [See *KSR* 82, USPQ2d, 1385, 1295 (2007), emphasis added.] Applicant submits that, due to the nature and desired performance of the claimed features, the features of Claim 1 are not predictable to one of skill in the art from the combination of Roberts and Scari. The Office Action found Applicant’s previous arguments that the combination of Roberts and Scari would not yield predictable results to be unpersuasive and invited Applicant to submit proof to the contrary. Submitted herewith is a Section 1.132 Declaration of Jonathon Roberts, in which it is declared that the inventors surprisingly found the combination of a mica layer and twist-free glass fiber provide substantially and unpredictably improved electrical insulating performance as compared to standard mica tape insulation materials. In addition to the detailed results submitted in the Roberts Declaration, these improvements are also illustrated in Table III of the specification which provides comparative data showing that the dissipation factor (under “Experimental”), i.e. a claimed feature, is markedly lower (specifically, 67.6 % lower) than standard mica tape (under “Control 2”).

With respect to independent claim 21, Applicant submits that this claim includes all the features of Claim 1, and thus is not obvious in view of Roberts and Scari for the same reasons that Claim 1 is not obvious. With respect to dependent claims 2-5, 7-13 and 22-27, Applicant submits that these claims are not obvious in view of Roberts and Scari for the same reasons that Claim 1, from which they depend, is not obvious as set forth above.

Improper reliance on the doctrine of inherency

The Office Action takes the position that because mica, glass and polymers have inherent properties that provide heat resistance and dissipation factors, it is presumed that the combination of Roberts and Scari would have certain inherent properties set forth in the claims. However, as shown above, the claimed features yield results for critical properties that are far outside the range of Roberts and is far superior than the cited art. One of ordinary skill in the art who manufactures mica tapes would not have expected the combination of Scari and the resin-rich mica tape disclosed in Roberts to have achieved such unexpected, significant results.

In rejecting the cited claims under 35 U.S.C. §103, the Office Action concedes that neither Roberts or Scari expressly or impliedly teach certain of the claimed properties. (Office Action, pp. 6-7, 9). In an attempt to over to overcome this admission, the Office Action rejects the claims on grounds that the claimed properties are inherent in the combination of Roberts and Scari. Applicant respectfully traverses this rejection on grounds that the Office Action has not met its burden to fully develop reasons supporting its reliance on the doctrine of inherency. The MPEP expressly instructs that: "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Further, since a basis in fact and technical reasoning is required when inherency is invoked, a failure to provide such evidence or rationale is fatal to the reliance on this doctrine. (*See* MPEP 2112).

A review of pages 6-7 and 9 of the Office Action reveals the absence of the required rationale or evidence at least tending to show that superior properties of the claimed features inevitably flow from the disclosures in Scari and Roberts. Indeed, the Office Action merely asserts "mica, glass and polymer have inherent properties that provide heat resistance and dissipation factors." (Office Action, page 9). This blanket assertion is merely conclusory and does not properly establish support for the Office Action's reliance on inherency. Therefore, the Office Action's reliance on inherency is unsupported and thus improper.

Furthermore, it is well settled that subject matter is inherent only when extrinsic evidence makes it clear that the subject matter necessarily flows from a disclosure of cited art. (MPEP 2112). The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed Cir. 1993). A review of Scari and Roberts reveals that the claimed properties do not necessarily flow from the cited art. For example, Roberts teaches that “too little resin will create voids in the final insulation leading to reduced dielectric properties.” [Roberts, Col. 2, lines 63-65]. Therefore, the claimed reduction in resin content would not necessarily always result in an improved insulation material with an increased thermoconductivity and a reduced dissipation factor. Similarly, Scari teaches that the use of zero-twist yarns allows one to use larger diameter glass fibers, which in turn provides for a greater glass content and also thicker fabric. [Scari, Col. 7, lines 60-65; Col. 8, lines 44-46]. Therefore, the claimed increase in the glass-to-mica ratio in the insulating material would not always result from a combination of Scari and Roberts. These express teachings preclude reliance on the doctrine of inherency as a matter of law. Accordingly, the subject matter alleged by the Office Action to be inherent cannot reasonably be said to necessarily flow from the combination of the Roberts and Scari patents. Thus, the Office Actions’s current reliance on inherency does not satisfy the standard set forth in MPEP § 2112 for a proper reliance on inherency.

In sum, contrary to the teachings of *KSR*, the improved insulating properties provided by aspects of the claims are not predictable from the disclosure of Roberts and Scari. As set forth in the Roberts Declaration submitted herewith, the substantially improved performance of the claimed features as an electrical insulator were highly unexpected, and would not have been obvious from a combination of Roberts and Scari. Furthermore, the Office Action improperly relies on the doctrine of inherency in rejecting claims 19-20 and 23-27. Thus, the Applicant respectfully submits that the features recited in claims 1-5, 7-13, and 19-27 are not obvious in view of Roberts and Scari.

II Response to Obviousness Rejection Based upon Roberts, Scari, and Andres

The Office Action rejected claim 6 pursuant to 35 U.S.C. §103(a) as obvious in view of the combined teachings of Roberts, Scari, and U.S. Patent 4,34,153 of Andres et al. [herein "Andres"]. Applicant respectfully submits that Andres does not address the deficiencies of Roberts and Scari, and claim 6 is non-obvious for the same reasons that claim 1, from which it depends, is non-obvious.

III. CONCLUSION

The Applicant believes that the above Amendments and Remarks place the application in allowable form. An early and favorable action on the merits of the application is requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, the Applicant's undersigned invites the Examiner to telephone her at the number provided.

Respectfully submitted,



Alana M. Fuieler
Attorney for Applicants
Registration No. 51,709

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HESLIN ROTHENBERG FARLEY & MESITI P.C.

5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579